

REMARKS

1. Preliminary Remarks

a. Status of the Claims

Claims 1-13 are pending in this application. Claims 1, 2, 6, 8, 9, and 11 are amended. Applicant respectfully requests entry of the amendments and remarks made herein into the file history of the application. Upon entry of the amendments, claims 1-13 will be pending and under active consideration.

b. Amendments to the Claims

Claims 1, 6, 8, 9, and 11 are amended to correct typographical errors. Claim 2 is amended to clarify that the immobilization occurs via the single-stranded overhang of the first ligation product, support for which is found at page 58 and Figure 1 of the application as originally filed.

c. Amendments to the Specification

The abstract is amended to comply with the requirements of 37 C.F.R. § 1.72.

d. Informalities

At item 5 of the Office Action, the Examiner points out a typographical error in the limitation, “avidine, streptavidine, extravidine” of claim 11. Amended claim 11 corrects the error, thereby obviating the objection.

The Examiner also asks Applicant to consider the guidelines set forth in MPEP § 601 regarding arrangement of the specification. In the absence of any specific deficiencies in the instant specification, Applicant is unsure as to what the Examiner is referring. Accordingly, no additional amendments have been made to the specification.

e. Priority

At item 2 of the Office Action, the Examiner notes that the instant application claims the benefit of European Patent Application No. 0400146.3, filed on January 23, 2004, but that Applicant has not filed a certified copy of this application. Submitted herewith is a certified copy of the foreign priority application, which was transmitted to the International Bureau in compliance with PCT Rule 17.1(a) or (b).

2. Patentability Remarks

a. 35 U.S.C. § 112, second paragraph

At item 6 of the Office Action, the Examiner rejects claims 1-13 under 35 U.S.C. § 112, second paragraph for allegedly being indefinite for failing to particularly point out and distinctly

claim the subject matter which applicant regards as the invention. In particular, the Examiner asserts that there is insufficient antecedent basis for the limitation “the first type II restriction enzyme” in step d) of claim 1, since step b) recites “a first type **IIS** restriction enzyme” (emphasis added). Amended claim 1 now recites “the first type IIS restriction enzyme,” thereby obviating the rejection.

The Examiner also asserts that the limitation, “the long single-stranded overhang” of claim 2 lacks support in claim 1, since step c) of claim 1 does not recite that the first ligation product comprises a long single stranded overhang. Amended claim 2 now relates to a step in which the first ligation product is immobilized via the single-stranded overhang of the first ligation product. Step c) of claim 1 recites that the, “the first ligation product comprises a single-stranded overhang,” thereby providing support for amended claim 2. In view of the foregoing, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of the claims under 35 U.S.C. § 112, second paragraph.

b. 35 U.S.C. § 102

At item 7 of the Office Action, the Examiner rejects claims 1-13 under 35 U.S.C. § 102 as allegedly being anticipated. Specifically, the Examiner rejects the claims under 35 U.S.C. § 102(a) based on EP 1 411 122 A1 (“Schatz I”), under 35 U.S.C. § 102(b) based on US2006/0115850A1 (“Schatz II”), and under 35 U.S.C. § 102(e) based on US 2006/0194202 A1 (“Schatz III”). Applicant respectfully disagrees

Applicant submits that the Examiner has misconstrued the teachings of the cited references. The instant claims relate to a method that includes ligating a first at least partially double-stranded oligonucleotide that has **a first and a second single-stranded overhang** to a second at least partially double-stranded oligonucleotide that includes a type IIS restriction enzyme recognition site, a modification allowing the oligonucleotide to be coupled to a surface, as well as a single-stranded overhang. None of the cited references disclose a ligation step that includes an at least partially double-stranded oligonucleotide that includes two single-stranded overhangs. Schatz I discloses only an at least partially double-stranded oligonucleotide that has one single-stranded overhang. *See* Schatz I at page 4, paragraph 10, step a) (“...providing a first at least partially double-stranded oligonucleotide which... comprises a single-stranded overhang”) (emphasis added) *and* at Figure 1 (clearly indicating two hairpin loop-structured oligonucleotides that each have only **one** single-stranded overhang).

Schatz II likewise teaches hairpin loop-structured oligonucleotides that each have only one single stranded overhang. *See, e.g.*, Figure 1. The teachings of Schatz are also limited to oligonucleotides with only one single-stranded overhang. *See, e.g.*, Figure 1. Accordingly, Schatz I, Schatz II, and Schatz III cannot anticipate the subject matter of the instant claims because these references fail to teach or suggest all of the limitations of instant claim 1. *See* MPEP § 2131 *quoting* *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628 (Fed. Cir. 1987) (“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference”). In view of the foregoing, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of the claims under 35 U.S.C. § 102.

3. Conclusion

Applicant respectfully submits that the instant application is in good and proper order for allowance and early notification to this effect is solicited. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the instant application, the Examiner is encouraged to call the undersigned at the number listed below.

Respectfully submitted,

POLSINELLI SHUGHART PC

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On behalf of: Lisa V. Mueller
Registration No. 38,978

By: /Paul A. Jenny/
Paul A. Jenny
Registration No. 59014
Customer No. 90080

POLSINELLI SHUGHART PC
161 N. Clark St., Ste. 4200
Chicago, IL 60601
312.819.1900 (main)
312.873.2932 (E-fax)
312.873.3632 (direct)